

REMARKS

A. Introduction

Claims 1-20 were presented for examination.

Examiner objected to Claims 2, and 13-16.

Claims 1-3, 4-11, 12, 13, 15, 16, and 17-20 were rejected.

Claims 18 and 20 are amended.

Claim 19 is canceled.

Claim 21 is added.

B. Claim Objections

Examiner objected to Claim 2 as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant previously canceled Claim 2 and previously amended Claim 1 and respectfully requests Examiner to withdraw this objection.

C. Claim Rejections Under 35 U.S.C. § 102

Examiner rejected Claims 1-3 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,458,388 to Genis et al (Genis). Applicant previously canceled Claim 2 and respectfully requests Examiner to withdraw the rejection with respect to Claim 2.

A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); Manual of Patent Examining Procedures (M.P.E.P.) § 2131.

Examiner states that Genis discloses a composition comprising Dead Sea salt granules, having particle size of 0.1-0.3 mm, which is less than the claimed size.

Examiner simply misinterprets Genis. Although the particle size is less than the claimed size, the salts used in the Genis reference are preferably sodium chloride or potassium chloride (col. 2, lines 60-61). In other words, Genis does not disclose Dead Sea salts in granule form, but simply an added ingredient to the composition. This is further evidenced by Genis disclosing that the “cream also contains mixture of mineral salt.” (col. 2, lines 63-64). Further, Genis discloses that the aqueous solution contains a “combination of dead sea salts as mineral solutes.” (col. 2 lines 48-51).

Genis gives two examples of the consistency of the cosmetic cream. In its first example, the salt granules are either potassium chloride or sodium chloride, not Dead Sea salt granules. In the second example, the salt is *exclusively* potassium chloride. Therefore, the particle size of the salt granules referred to in the Genis reference are either sodium chloride or potassium chloride, but not Dead Sea salts. Dead Sea salts are added to the mixture in the aqueous solution.

Additionally, Genis fails to disclose that the Dead Sea salts are processed into ultra fine particles prior to their use in the composition. The Dead Sea minerals of the present invention simply cannot be fractionalized further without the addition of artificial ingredients. Thus, Genis fails to disclose the limitations of “processed Dead Sea mineral particles, having a size less than about 10 mesh,” as recited in independent Claim 1.

Examiner states that Genis discloses the steps of mixing Dead Sea salt with an emulsifier at a temperature higher than room temperature, homogenizing the mixture and cooling; and subjecting the mixture to another heating and cooling cycle. However, Genis does not teach that the method of manufacturing cosmetic preparations contains the limitation of “at least 50% processed Dead Sea mineral particles, having a size less than

about 10 mesh,” as recited in Claim 1.

Examiner interprets the limitation of Claim 1 of “at least 50% processed Dead Sea mineral particles” as out of the total amount of Dead Sea minerals in the cosmetic composition, at least 50% of the minerals are processed and in the form of particles. Examiner interprets incorrectly.

In the present invention, all Dead Sea minerals in the composition are processed. The correct interpretation is that the Dead Sea minerals make up at least 50% of the total composition. This was expressly indicated in the specification disclosing that the final composition was approximately 51% ultra fine Dead Sea minerals, 25% palm oil, 9.0% soybean oil, 5.0% olive oil, 3.0% jojoba oil, 3.0% beeswax, 1.0% essential oil blend, 1.0% jojoba wax PEG 120, 1.0% cashew husk oil ethoxylate, 1.0% coconut oil, 0.1% natural source Vitamin E oil or d alpha tocopherol, 0.5% Vitamin E or natural mixed tocopherols. (Specification page 19, line 21 through page 20, line 5). If all the percentages are added up, they total 100.6%.

Clearly, Applicant’s description of “approximately 51% ultra fine Dead Sea minerals” is of the entire composition, not just the ultra fine Dead Sea minerals making up part of the entire Dead Sea minerals. Genis, on the other hand, limits its contents of the Dead Sea salts as mineral solutes in the aqueous solution, comprising approximately 5.86% of the cosmetic cream. (col. 4, table 2).

Examiner states that the particles of Genis have the same size as claimed in the present invention and hence meet “the processed” and mesh size limitations of Claims 16 and 18. Applicant respectfully notes that neither Claim 16 nor Claim 18 involves “processed” or mesh size limitations for the present invention. Rather, Claim 16 of the

present invention deals with an essential oil blend comprising calendula. Claim 18 of the present invention deals with heating and cooling steps. Both Claims 16 and 18 of the present invention are discussed later in this paper under the appropriate sections.

Examiner states that Genis discloses Dead Sea particles of same particle size and in a cosmetic medium containing Vitamin E, and thus the property of not settling out of carrier medium is inherent to the composition of Genis. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2112.

First, as previously noted, Genis does not contain processed Dead Sea mineral particles. Second, the Dead Sea salts in Genis are in solution and not in suspension. Third, although the carrier medium in the invention contains Vitamin E, Examiner implies that Vitamin E is the sole basis of why the property of not settling out of the carrier medium is inherent to the composition of Genis. The present invention contains many more constituents other than Vitamin E. The Dead Sea mineral composition of the present invention also contains palm oil, soybean oil, olive oil, jojoba oil, beeswax, essential oil blend, jojoba wax PEG 120, cashew husk oil ethoxylate, and coconut oil.

Examiner failed to provide a basis in fact and/or technical reasoning to reasonable support the determination that the allegedly inherent characteristic necessarily flows from the teachings of Genis. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)(emphasis in original); M.P.E.P. § 2112. Therefore, the property of not settling out of “carrier medium” cannot be attributed solely to Vitamin E. Thus, Genis fails to disclose the limitation of Claim 3 that “Dead Sea minerals do not rapidly settle out of said

carrier medium.”

Examiner states that the instant claims do not state if 50% is pertaining to the concentration of Dead Sea salts in the composition, but that Genis discloses Dead Sea salts in the composition in an amount of 5 to 40 parts and thus anticipates the instant claims. Applicant respectfully disagrees.

As previously demonstrated above, the specification of the instant invention expressly states that the 50% is pertaining to the total concentration of Dead Sea salt in the composition. Contrary to Examiner’s assertion, Genis does not disclose Dead Sea salts in the composition in the amount of 5 to 40 parts. The “5 to 40 parts” referenced in Genis refers to a mixture of: (1) mineral salts which are dissolved in the aqueous solution; (2) dissolved sodium chloride and potassium chloride, and (3) solid granular sodium chloride and/or potassium chloride.

The Genis reference simply fails to disclose “cosmetic preparation precursors comprise at least 50% processed Dead Sea mineral particles, having a size less than about 10 mesh,” as recited in Claim 1. Genis also does not disclose “a mixture of at least 50% processed Dead Sea minerals in a continuous all-natural carrier medium wherein said Dead Sea minerals do not rapidly settle out of said carrier medium” as recited in Claim 3. In short, Genis simply does not anticipate Claims 1 or 3.

D. Claims 17-20 Rejected Under 35 U.S.C. § 103

Examiner rejects Claims 17-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,458,388 to Genis et al (Genis). Applicant considered these rejections and amended Claim 18 to include additional limitations not claimed or anticipated by Genis. Claim 20 was also amended to depend from Claim 17. Applicant

also canceled Claim 19 and added new Claim 21. With respect to Examiner's rejection of Claim 17, Applicant respectfully disagrees.

Examiner bears the initial burden of establishing a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be some reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not be based on applicant's disclosure. Manual of Patent Examining Procedure (M.P.E.P. § 2142); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Examiner failed to establish a *prima facie* case of obviousness.

1. Teaching or Suggestion of All Claim Limitations

To establish *prima facie* obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03. As previously noted, Genis does not teach or suggest the claim limitation "cosmetic preparation precursors comprise at least 50% processed Dead Sea mineral particles, having a size less than about 10 mesh," as recited in Claim 1. Applicant respectfully reasserts those arguments made above.

Genis also fails to teach "consecutive heating and cooling cycles comprise the step of heating said process vessel to about 65 degrees Celsius," as recited in Claim 17. In fact, Genis continues to heat its oil and water mixture (which contains no Dead Sea

salt granules) as high as 80 degrees Celsius. (col. 4, lines 9-10).

Genis further fails to teach the limitation of “cooling step occurs at a rate of at least 200 gallons in about two hours or less,” as recited in amended Claim 18. Further still, Genis fails to teach the limitation “consecutive heating and cooling cycles further comprise the step of cooling said process vessel to about 42 degrees Celsius,” as recited in amended Claim 20.

Genis simply provides too broad a variance regarding the temperatures used in its process. Additionally, Genis does not disclose the swift heating and cooling technique utilized in the present invention. Genis simply does not teach or suggest all of the claim limitations of Claims 17, amended Claims 18 and 20, and new Claim 21 of the present invention. Applicant respectfully submits that Examiner’s 35 U.S.C. § 103 rejections are overcome.

2. Non-Analogous Art

To rely on references under 35 U.S.C. § 103, the references must be analogous prior art. M.P.E.P. § 2141.01(a). In order to rely on a reference as a basis for a rejection of an applicant’s invention, the reference must be either in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992).

Examiner states that Genis teaches the general process of subjecting the components of the composition containing Dead Sea salts and that the temperatures used are not significantly different from the temperatures of the present invention. Applicant respectfully disagrees.

The present invention’s use of its unique swift heating, cooling and mixing

technique makes the specified temperatures critical to the process. Moreover, the process occurs in about two hours or less. In contrast, Genis uses a broad range of temperatures. Further, Genis does not indicate any range of time in which the process is to be completed.

The present invention maintains an entirely anhydrous composition which utilizes an oil base. The present invention also processes the Dead Sea mineral particles into ultra fine particles. It is the combination of the use of oil with the ultra fine Dead Sea mineral particles that keeps and ensures significantly high concentrations of Dead Sea mineral salts stay in suspension. This, in turn, maintains its stability and increases its shelf life for the consumer.

In contrast, Genis uses an oil-water base composition where the Dead Sea salts are dissolved in the aqueous phase of the composition. There is no suspension of Dead Sea salts. There are no Dead Sea salts processed into ultra fine particles. There is no all natural carrier medium.

The differences in ingredients and mediums used for the present invention and for Genis dictate that different specific temperatures be used to achieve the results desired by the present invention. The present invention also optimized the time in which to complete the process and achieve those results. Genis does not accomplish these objectives. Thus, Genis is not analogous to the present invention.

3. Suggestion to Combine References

There exists no suggestion to use Dead Sea salts in granular form, process the Dead Sea salts to ultra fine particles, or use an oil based carrier medium in Genis. Further, the Genis composition is based on an emulsion of oil and water. (col. 3, lines

24-26). In contrast, the present invention is oil based and completely anhydrous. Clearly, these different constituents (oil-water vs. oil-oil) demand separate temperature considerations. For example, some constituents of the present invention may become unstable or even break down at temperatures above 65 degrees Celsius, causing the cosmetic composition to degrade.

There simply would not be a reasonable expectation of success to modify the present invention to use both the oil and water base emulsion and the elevated temperatures for an unspecified amount of time as disclosed in Genis. This would yield catastrophic results. The present invention's composition would be unable to maintain the significantly high concentrations of ultra fine Dead Sea mineral particles in suspension. Moreover, the shelf life of any product processed in this manner would dramatically be reduced or disappear altogether.

Contrary to Examiner's contention, it would not have been obvious to one of an ordinary skill in the art at the time of the instant invention to optimize the temperature range or exact temperatures of heating and cooling cycles, such that a homogenized cream containing Dead Sea salt granules (which Genis does not) would be stable upon storage and would not disappear.

E. Claims 12, 13, 15, and 16 Rejected Under 35 U.S.C. § 103

Examiner rejects Claims 12, 13, 15, and 16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,458,388 to Genis et al (Genis) in view of EP 1074245 (EP '245). Applicant respectfully disagrees.

As previously noted, the Genis reference does not teach or suggest any of the claim limitations of independent Claim 1. Applicant respectfully reasserts those

arguments made above. Further, Genis fails to cite the limitation of “an essential oil blend” as in Claim 12. In fact, Genis does not teach “essential oil blend comprises lavender” as in Claim 13, “essential oil blend comprises chamomile” as recited in Claim 15, or “essential oil blend comprises calendula” as recited in Claim 16. These claim limitations are simply not found in the Genis reference.

Examiner cites the EP ‘245 reference as containing 5% Dead Sea salts and other herbs and aromatic essences such as lavender, chamomile, and calendula. However, while EP ‘245 does contain some Dead Sea salts, EP ‘245 fails to teach the limitation of “an essential oil blend” as recited in Claim 12. EP ‘245 does disclose lavender as an aromatic essence, however, it is coupled with geranium for PMS relief. (Table on page 9 continuing to page 10). Lavender is also coupled with Orange Blossom and Vetivyr for total relaxation. (Table on page 9 continuing to page 10). However, lavender does not make up a component of “an essential oil blend” as recited in Claim 12. Thus, EP ‘245 fails to teach “essential oil blend comprises lavender” as in Claim 13.

Chamomile is used either as an aromatic essence along with Melissa and Linden, or as an organic herb with calendula and clove. In either form, it is used for skin calming. (Table on page 9 continuing to page 10). However, neither chamomile nor calendula make up a component of “an essential oil blend” as recited in Claim 12. As with lavender, EP ‘245 fails to teach the limitations of “essential oil blend comprises chamomile” as recited in Claim 15, or “essential oil blend comprises calendula” as recited in Claim 16. Like Genis, and contrary to Examiner’s contentions, these limitations are not found in the EP ‘245 reference.

2. Non-Analogous Art

Genis teaches a cosmetic composition in an oil and water base where the granules are composed of either sodium chloride or potassium chloride. However, Genis does not include the use of the specific essential oils of the present invention.

EP '245 makes no reference to rosewood. Moreover, EP '245 uses lavender, chamomile, and calendula separately or with at most one additional aromatic essence of the present invention, *e.g.*, chamomile with calendula. In contrast, the present invention uses lavender, rosewood, chamomile, and calendula together. Each of these oils come together, maximizing each of their individual therapeutic benefits together in synergistic harmony, to make up the essential oil blend in the present invention.

Examiner stated that the process of preparing the composition of EP '245 was the same as that of the present invention because the present invention *also* described the use of ultra fine Dead Sea salts for a homogenous mixing so as to maintain uniformity of the solid suspension. Even assuming that "[m]ix well until completely dissolved," the reference of page 7 of EP '245 that Examiner indicates (which is the only mixing done where Dead Sea salts are involved), is the equivalent to homogenous mixing, EP '245 simply does not utilize ultra fine Dead Sea salts with an the essential oil blend of lavender, rosewood, chamomile, and calendula. Therefore, the present invention cannot be considered obvious in light of Genis alone or Genis in view of EP '245.

3. Suggestion to Combine References

There is no suggestion to use cosmetic aroma agents with Dead Sea salts in Genis. There is no suggestion to use cosmetic aroma agents with Dead Sea salts of a concentration of more than 10% in EP '245. There is no suggestion in EP '245 to use

cosmetic aroma agents with Dead Sea salts which were processed into ultra fine particles and suspended in an oil based carrier medium. Finally, there is no suggestion to combine lavender, rosewood, chamomile, and calendula into an essential oil blend in either Genis or EP '245.

Therefore, there would not be any reasonable expectation of success to modify or to combine the few cosmetic aroma agents claimed in EP '245 with the composition of Genis to improve properties of the cosmetic and cleansing composition. Such combination would not give the expected result of achieving the desired effects of a significantly high concentration of ultra fine Dead Sea mineral particles suspended in an oil based carrier medium with improved relaxation from the aromatic agents. Examiner improperly rejected Claims 12, 13, 15, and 16.

F. Claims 4-11 Rejected Under 35 U.S.C. § 103

Examiner rejects Claims 4-11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,458,388 to Genis et al (Genis) and EP 1074245 (EP '245). Applicant respectfully disagrees.

1. Teaching or Suggestion of All Claim Limitations

Genis simply does not teach any of the limitations of the dependent Claims 4-11. Specifically, Genis fails to teach or suggest the “continuous all-natural carrier medium comprises palm oil” recited in Claim 4; “soybean oil” as in Claim 5; “olive oil” as in Claim 6; “jojoba oil” as in Claim 7; “beeswax” as in Claim 8; “jojoba wax” as in Claim 9; “cashew husk oil ethoxylate” as in Claim 10; and “coconut oil” as in Claim 11. This, and this alone, is sufficient to overcome Examiner’s rejections.

Not only does the primary reference of Genis not show the limitations contained

in dependent Claims 4-11, neither does EP '245. Similarly, Durr fails to teach or suggest the "continuous all-natural carrier medium comprises palm oil" recited in Claim 4; "soybean oil" as in Claim 5; "olive oil" as in Claim 6; "jojoba wax" as in Claim 9; "cashew husk oil ethoxylate" as in Claim 10; and "coconut oil" as in Claim 11.

The limitations of the rejected claims are simply not shown in Genis or EP '245. Examiner simply fails to cite any reference that includes all of the claimed limitations of the present invention. To combine a third reference now to reject dependent Claims 4-11 is taking the issue of obviousness to the extreme. Examiner improperly rejected Claims 4-11.

2. Non-Analogous Art

Both Genis and EP '245 are water based compositions. Durr even teaches that water may be used in the preparation of its composition (col. 4, lines 24-28). This is diametrically opposite to the present invention, which is entirely anhydrous.

The use of Dead Sea minerals varies dramatically in each cited reference. The Dead Sea salts used in Genis are solutes dissolved in an aqueous solution. EP '245 is silent on the size of the Dead Sea mineral salt granules but also fails to show that any processing is performed on the Dead Sea mineral salts such that they are ultra fine prior to their use in the composition. Finally, although Durr is a hand and body crème composition used for common skin ailments, Durr does not even contain any Dead Sea mineral salts.

The whole point of the present invention is to dramatically increase the concentration of Dead Sea minerals that can be introduced and remain in a cosmetic composition for ultimate absorption into the human skin. This is accomplished with a

unique swift heating, cooling and mixing technique of various ingredients. The cited references simply do not use the same chemistry as in the present invention and thus are not analogous.

3. Suggestion to Combine References

Genis does not suggest the use of ultra fine Dead Sea mineral particles suspended in an all natural carrier medium. Further, EP'245 does not suggest the use of significantly more Dead Sea salts than about 10%, or the use of ultra fine Dead Sea salts, or the use of an oil-based carrier medium. No suggestion exists to significantly increase the amount of Dead Sea salts, process the Dead Sea salts to ultra fine particles, or use an oil based carrier medium in EP '245. There is no suggestion in Durr to combine the fragrances and essential oil with ultra fine Dead Sea mineral particles. Moreover, there is no suggestion to even use Dead Sea salts in Durr.

There is simply no obvious suggestion to combine these references to come up with the claimed invention, whether using the initial Genis reference cited by the Examiner or ultimately all three references cited by the Examiner. Therefore, there would not be any reasonable expectation of success to modify or to combine the compositions claimed in these prior art references to choose an appropriate oil containing Dead Sea salts so as to provide the desired emolliency of the present invention.

Conclusion


In view of the above, the Applicant submits that Claims 1-20 are in condition for allowance. Applicant respectfully requests reconsideration and withdrawal of the rejections. Allowance of Claims 1-20 at an early date is solicited.

If the Examiner still finds impediments to allowance of Claims 1-20 and, in the

opinion of the Examiner, a telephone conference between the undersigned and the Examiner would help remove such impediments, the undersigned respectfully requests such a telephone conference.

Respectfully submitted,

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